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EXAMINER

VIG, NARESH

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/510,580

Applicant(s)

LEEDS, RICHARD A.

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 19 and 30 - 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 19 and 30 - 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

This is in response to reply received on 22 October 2002 to the office action mailed on 16 July 2002. Addition of claims 30 – 47, Cancellation of claims 1 –16, 18 and 20 – 29, and, amendment to claims 17 and 19 are acknowledged. There are 20 claims 17, 19 and 30 – 47 pending for examination.

Claim Rejections - 35 USC § 112

Claims 38 – 42 and 44 – 47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 38 – 42 and 44 – 47 reference home web page, whereas the disclosure in filing by the applicant does not support home web page. Examiner reads claims 38 – 42 and 44 – 47 as referencing to web page.

Response to Arguments

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Jacobi discloses the recommendation service to generate a list of additional items that are predicted to be of interest to the user. The additional items are preferably displayed to the user when the user views the contents of the shopping cart. Recommendations generated by the recommendation services are returned to the Web server, which incorporates the recommendations into personalized Web pages transmitted to users.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 19, 31 – 34 and 36 – 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobi et al. US Patent 6,317,722 hereinafter known as Jacobi in view of catalog shopping portal Catalog City (www.catalogcity.com) hereinafter known as CatalogCity and in further view of information retrieved from HowStuffWorks, Inc. website (www.howstuffworks.com).

Regarding Claims 17, 31, 39 and 40, Jacobi discloses a computer-implemented service and methods for recommending products or other items to individual users of an electronic commerce system based on a set of items known to be of interest to the user, such as a set of items currently in the user's electronic shopping cart. (abstract, col. 1, lines 6 – 9). The web site includes a Web server application ("Web server") which processes HTTP (Hypertext Transfer Protocol) requests received over the Internet from user computers. (Fig. 1)

Jacobi discloses plurality of web pages (see Fig. 6, for links to "Amazon.com Home", "Shopping Cart", "Your Account", "Recommendation Center". Also, Jacobi discloses using database to store information for items and users (col. 7, lines 30 – 45). Jacobi discloses web pages having domain names formatted as a URL (Fig. 6). The data stored for each user may include one or more of the following types of information (among other things) that can be used to generate recommendations in accordance with the invention: (a) the user's purchase history, including dates of purchase, (b) the user's item ratings profile (if any), (c) the current contents of the user's personal shopping cart(s), and (d) a listing of items that were recently (e.g., within the last six

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months) removed from the shopping cart(s) without being purchased ("recent shopping cart contents"). If a given user has multiple shopping carts, the purchase history for that user may include information about the particular shopping cart used to make each purchase. (col. 7, lines 44 – 64)

Jacobi discloses that the recommendation service identifies items that are currently in the user's shopping cart, and uses these items to generate a list of additional items that are predicted to be of interest to the user, wherein an additional item is selected to include in the list based in-part upon whether that item is related to more than one of the items in the user's shopping cart. The additional items are preferably displayed to the user when the user views the contents of the shopping cart. Recommendations generated are returned to the Web server, which incorporates the recommendations into personalized (customized) transmitted to users (col. 8, lines 20 – 25). "The general form of such a Web page is shown in FIG. 6, which lists five recommended items. From this page, the user can select a link associated with one of the recommended items to view the product information page for that item. In addition, the user can select a "more recommendations" button 200 to view additional items from the list of M items". (col. 16, lines 6 – 14). Jacobi does not disclose how the user is identified before the recommendations are made. It is known at the time of applicant's invention to a person with ordinary skill in the art that for an online shopping, users are required to log-in into the vendors website, or, vendors use the information stored on users computer (cookies) to identify the user. Therefore, it is known at the time of applicant's invention to a person with ordinary skill in the art to include user identification

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means and method to identify the user for determining their preferences prior to making recommendations.

Jacobi does not disclose to exclude selected information in the merchandise database from being displayed. It is known at the time of applicant's invention that user's access to database information is limited to their authorized requirements. (for example, Human Resources personnel can view name, address, age, benefits etc. for the entire organization, whereas, a manager may be restricted to access employees name, address, contact information only). Therefore, it is known at the time of applicant's invention to a person with ordinary skill in the art to limit the information from merchandise database for user's viewing to stay competitive by protecting the actual cost of the products being sold from their competitors and users.

Jacobi web site includes a web server application ("Web server") which processes HTTP (Hypertext Transfer Protocol) requests received over the Internet from user computers (col. 7, lines 35 – 38).

Jacobi does not disclose computer readable medium for storing computer programs. However, Jacobi et al. discloses that although the embodiments described herein employ item lists, other programming methods for keeping track of and combining sets of similar items can be used (col. 17, lines 10 – 18). Also, it is known at the time of invention to a person with ordinary skill in the art that the computer programmers store computer programs on a computer readable medium (like a hard drive, CDROM etc.) to have the computer program readily available for the computer to

become functionally active with minimum human intervention in case when the system reboots (for example, when there is a power failure).

Jacobi does not disclose to identify which domain name was selected by the user. However, CatalogCity discloses to have plurality of domain names and provides links to the web site associated with the domain names. It is obvious that CatalogCity has means and method to determine which domain is selected by the user to make the system functional. Therefore, it is known at the time of invention to a person with ordinary skill in the art to determine user selection of domain name to be able to transfer user to that domain and generate revenue as a referral fee paid for by the vendor.

Regarding claim 19, Jacobi discloses the recommendation service to identify items that are currently in the user's shopping cart, and uses these items to generate a list of additional items that are predicted to be of interest to the user, wherein an additional item is selected to include in the list based in-part upon whether that item is related to more than one of the items in the user's shopping cart. The additional items are preferably displayed to the user when the user views the contents of the shopping cart. Recommendations generated by the recommendation services are returned to the Web server, which incorporates the recommendations into personalized Web pages transmitted to users. The web site includes a Web server application ("Web server") which processes HTTP (Hypertext Transfer Protocol) requests received over the Internet from user computers.

Jacobi et al. does not disclose to categorize information on the screen. Linden et al. discloses to categorize information on user's screen (see Fig 5). Therefore, it is known at the time of applicant's invention to a person with ordinary skill in the art to categorize information on user screen to present the information in a user friendly manner and lure the user to consider the recommendations.

Regarding claim 30, Jacobi does not disclose IP address to be network address. However, Jacobi discloses that requests are received over the internet from remote computers. Also, it is known at the time of invention to a person with ordinary skill in the art that internet uses unique IP addresses to identify hosts for exchanging information. Therefore, it is obvious that Jacobi has means and method to determine the IP address of the remote user to secure user information and maintain one to one communication for transactions.

Regarding claim 32, Jacobi does not discloses to include plurality of domain names. CatalogCity discloses to have plurality of domain names and provides links to the web site associated with the domain names. Also, inclusion of selected domain names is a design choice. Therefore, it is known at the time of invention to a person with ordinary skill in the art to provide links to other domain names to generate revenue as a referral fee paid for by the vendor.

Regarding claim 33, Jacobi discloses database to store information about item for sale (e.g. shopping cart, see Fig. 1).

Regarding claims 34, 37, Jacobi discloses that the Instant Recommendations service generates the recommendations based exclusively on the purchase history and any item ratings profile of the particular user (uniquely customized). Any of a variety of other methods can be used to initiate the recommendations generation process and to display the recommendations to the user. For example, the recommendations can automatically be generated periodically and sent to the user by e-mail, in which case the e-mail listing may contain hyperlinks to the product information pages of the recommended items. Further, the personal recommendations could be generated in advance of any request or action by the user, and cached by the Web site until requested.

Regarding claim 36, Jacobi does not disclose screen design having colors, pictures, shapes etc. However, Jacobi discloses that its Web server accesses a database of HTML (Hypertext Markup Language) content which includes product information pages and other browsable information about the various products of the

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catalog. Also, it is notoriously known that HTML a "markup language" is a computer language that describes how a page should be formatted. HTML is not used to display a long string of black and white text with no formatting. When there is a need to change fonts, add colors, create headlines and embed graphics in your page, HTML is the language used to do it (see How Web Pages Work). Therefore, it is known at the time of applicant's invention to a person with ordinary skill in the art to use a language like HTML to design user interface to direct customer's attention to the recommendations and increase online sales.

Regarding claim 38, Jacobi web site includes a "user profiles" database which stores account-specific information about users of the site. Because a group of individuals can share an account, a given "user" from the perspective of the web site may include multiple actual users. The data stored for each user may include the information that can be used to generate recommendations. If a given user has multiple shopping carts, the purchase history for that user may include information about the particular shopping cart used to make each purchase (col.7, lines 45 – 64).

The Instant Recommendations service generates the recommendations based exclusively on the purchase history and any item ratings profile of the particular user (uniquely customized). Any of a variety of other methods can be used to initiate the recommendations generation process and to display the recommendations to the user. For example, the recommendations can automatically be generated periodically and

sent to the user by e-mail, in which case the e-mail listing may contain hyperlinks to the product information pages of the recommended items. Further, the personal recommendations could be generated in advance of any request or action by the user, and cached by the Web site until requested.

Regarding claim 41, Jacobi discloses that The Amazon.com Web site includes functionality for allowing users to search, browse, and make purchases from an online catalog of several million book titles, music titles, video titles, and other types of items. Using a shopping cart feature of the site, users can add and remove items to/from a personal shopping cart which is persistent over multiple sessions. (As used herein, a "shopping cart" is a data structure and associated code which keeps track of items that have been selected by a user for possible purchase.)

Regarding claim 42, Jacobi discloses the Web site which includes a Web server application ("Web server") which processes HTTP (Hypertext Transfer Protocol) requests received over the Internet from user computers. The Web server accesses a database of HTML (Hypertext Markup Language) content which includes product information pages and other browsable information about the various products of the catalog. It is obvious that Jacobi server handles HTTP headers.

Regarding claim 43 and 46, Jacobi discloses using database to store information for items and users (col. 7, lines 30 – 45).

Jacobi does not disclose to determine network address of the user. However, Jacobi discloses that requests are received over the internet from remote computers. Also, it is known at the time of invention to a person with ordinary skill in the art that internet uses unique IP addresses to identify hosts for exchanging information. Therefore, it is obvious that Jacobi has means and method to determine the network address of the remote user to secure user information and maintain one to one communication for transactions.

Jacobi discloses the recommendation service to identify items that are currently in the user's shopping cart, and uses these items to generate a list of additional items that are predicted to be of interest to the user, wherein an additional item is selected to include in the list based in-part upon whether that item is related to more than one of the items in the user's shopping cart. The additional items are preferably displayed to the user when the user views the contents of the shopping cart. Recommendations generated by the recommendation services are returned to the Web server, which incorporates the recommendations into personalized Web pages transmitted to users.

Regarding claims 44 – 45 and 47, Jacobi does not disclose to include plurality of domain names and identify which domain name was selected by the user. However,

CatalogCity discloses to have plurality of domain names and provides links to the web site associated with the domain names. It is obvious that CatalogCity has means and method to determine which domain is selected by the user to make the system functional. Therefore, it is known at the time of invention to a person with ordinary skill in the art to determine user selection of domain name to be able to transfer user to that domain and generate revenue as a referral fee paid for by the vendor.

Jacobi discloses using database to store information for items and users (col. 7, lines 30 – 45).

Jacobi does not disclose to determine network address of the user. However, Jacobi discloses that requests are received over the internet from remote computers. Also, it is known at the time of invention to a person with ordinary skill in the art that internet uses unique IP addresses to identify hosts for exchanging information. Therefore, it is obvious that Jacobi has means and method to determine the network address of the remote user to secure user information and maintain one to one communication for transactions.

Jacobi discloses the recommendation service to identify items that are currently in the user's shopping cart, and uses these items to generate a list of additional items that are predicted to be of interest to the user, wherein an additional item is selected to include in the list based in-part upon whether that item is related to more than one of the items in the user's shopping cart. The additional items are preferably displayed to the user when the user views the contents of the shopping cart. Recommendations

generated by the recommendation services are returned to the Web server, which incorporates the recommendations into personalized Web pages transmitted to users.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobi et al. US Patent 6,317,722 hereinafter known as Jacobi in view of catalog shopping portal Catalog City (www.catalogcity.com) hereinafter known as CatalogCity and in further view of information retrieved from HowStuffWorks, Inc. website (www.howstuffworks.com) and online retailer Amazon.com, Inc. (www.amazon.com) hereinafter known as Amazon.

Regarding claim 35, Jacobi does not disclose advertisement area. Amazon discloses advertisement area. Amazon discloses advertisement area to advertise the products area they sell, and also, discloses to provide links to their affiliate sites to get information on their products and services (page 3). Therefore, it is known at the time of invention to a person with ordinary skill in the art to have advertisement area to inform customers what products are for sale, what items are specially priced, mention of other sites which have affiliation relationship etc.

Jacobi et al. does not disclose to categorize information on the screen. Linden et al. discloses to categorize information on user's screen (see Fig 5). Therefore, it is known at the time of applicant's invention to a person with ordinary skill in the art to

categorize information on user screen to present the information in a user friendly manner and lure the user to consider the recommendations.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. The Original HTTP As Defined In 1991
2. Anatomy Of A URL

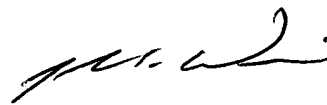
3. Quick Reference To HTTP Header
4. A Beginner's Guide To HTML
5. Information On HTTP Header Viewer

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

January 17, 2003



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600